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10/808,701	03/25/2004	Philippe Msika	065691-0355	6071

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FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/808,701	<b>Applicant(s)</b> MSIKA, PHILIPPE	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/8/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/806,834, filed on April 5, 2001.

### ***Claim Objections***

Claims 1, 12, and 19 are objected to because of the following informalities:  
There is a grammatical error in reciting a noun and the noun modifier. See claims 1, 12, 19, lines 1-2, "a women". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Andary et al. (US 5719129) ("Andary"), as evidenced by Frei et al (Internat'l J. of Cosmetic Science) ("Frei").**

Claim 1 is directed to a method of reducing the formation of and/or treating skin stretchmarks in women during or after pregnancy or after puberty, comprising a composition to areas of skin liable to form stretchmarks or having stretchmarks,

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including skin of the thighs, abdomen, breast, and a combination thereof, the composition comprising, in a suitable vehicle, at least one soya peptide.

Andary discloses an anti-aging cream comprising 25 % of oraposide encapsulated in liposomes, which contains soya protein in 1 % by the total weight of the oraposide liposomes. See Example 8; instant claims 1 and 7. The scope of the claimed method encompasses a method for reducing the formation of skin stretchmarks in women after puberty, whose group is within the population of those who use anti-aging cream.

Claim 1 recites that “areas of skin liable to form stretchmarks” include the thighs, abdomen, breast, and a combination thereof, but does not exclude other areas onto which the user of the prior art anti-aging cream chooses to apply the composition. Thus, the claimed method is inherently practiced by using the prior art anti-aging cream to skin as intended.

Claims 2-4 are product-by-process claims. It is well settled in patent law that product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. See MPEP § 2123. The court in In re Thorpe held, “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” See 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In this case, fermented

soya peptide extracted from Lactobacillus bacterium is well known for increasing skin firmness, elasticity, and tone lost with aging. See Frei, abstract. The peptide is taught as having a molecular weight of 800-1300 Daltons. See p. 161; instant claim 5-6. Since both of the soya peptide proteins in Andary and Frei are known to have same efficacy in treating anti-aging signs of skin, examiner views it reasonable to conclude that these proteins are the same.

**Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Quelle (DE04244418A1, abstract).**

Claim 12 is directed to a method of reducing the formation of and/or treating skin stretchmarks in women during or after pregnancy or after puberty, comprising a composition to areas of skin liable to form stretchmarks or having stretchmarks, including skin of the thighs, abdomen, breast, and a combination thereof, the composition comprising, in a suitable vehicle, at least one tripeptide consisting of the amino acids glycine, histidine, and lysine.

Quelle discloses a method of using Gly-His-Lys tripeptide for skin care as an anti-aging agent and radical scavenger (antioxidant). See abstract.

Claim 12 recites that "areas of skin liable to form stretchmarks" include the thighs, abdomen, breast, and a combination thereof, but does not exclude other areas onto which the user of the prior art anti-aging cream chooses to apply the composition. The claimed method is inherently practiced by applying the prior tripeptide as taught by the reference.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-6, 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rapaport (US 5444091) in view of Frei et al (Internat'l J. of Cosmetic Science) ("Frei").**

Rapaport teaches a method of treating striae distensae lesions (stretchmarks) by topically applying to the affected skin a composition comprising alpha-hydroxy acids in the amount ranging from 2-30 % by weight, more preferably 5-20 % by weight. See Example; instant claims 1 and 9. The reference teaches lactic acid. See col. 3, lines 36 – 45; instant claim 10. The reference teaches that the composition promotes rigidity and elasticity of the skin. See col. 4, lines 31 – 38.

While Rapaport teaches adding other ingredients including anti-oxidants and botanical extracts and to protect, prepare or mediate the action of the composition on the skin, the reference fails to teach soya protein.

Frei teaches fermented soya peptide extracted from Lactobacillus bacterium for increasing skin firmness, elasticity, and tone. See abstract; instant claims 1-4. The peptide is taught as having molecular weight of 800-1300 Daltons. See p. 161; instant claim 5-6.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the composition of Rapaport by incorporating soya peptide,

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as motivated by Frei, because Rapaport teaches that stretchmarks are treated by promoting the rigidity and elasticity of the skin and suggests adding additives to enhance the performance of the product; and Frei teaches the effectiveness of soya protein in improving firmness and elasticity of skin. The skilled artisan would have had a reasonable expectation of successfully improving the method of treating stretchmarks since soya protein would improve the firmness and elasticity of the skin..

**Claims 12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rapaport in view of Quelle (DE 4244418).**

Rapaport, as discussed above, teaches a method of treating stretchmarks by topically applying to the affected skin a composition comprising alpha-hydroxy acids in the amount ranging from 2-30 % by weight, more preferably 5-20 % by weight. See Example; instant claims 12, 15-17.

Rapaport fails to teach tripeptide consisting of the amino acids glycine, histidine, and lysine.

Quelle teaches the use of tripeptide Gly-His-Lys in cosmetic compositions to treat the skin against aging and as radical scavenger (antioxidant). See abstract. With respect to instant claim 14, it is well within the skill of the art to discover an optimum weight amount of the anti-aging agent by routine experimentations.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the composition of Rapaport by incorporating the tripeptide Gly-His-Lys, as motivated by Quelle, because Rapaport teaches that stretchmarks are treated by promoting the rigidity and elasticity of the skin and suggests adding additives to enhance the performance of the product; and also teaches that the tripeptide

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counters the breakdown of collagen and stimulates the permanent production of interfibrillary material, which promotes both rigidity and elasticity; and Quelle teaches that the tripeptide promotes collagen synthesis and better antioxidant activity. The skilled artisan would have had a reasonable expectation of successfully enhancing the method of treating stretchmarks, since it is expected that the tripeptide would treat aging symptoms of the skin. .

**Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rapaport and Frei as applied to claims 1-6 and 8-10 as above, and further in view of Flick (Cosmetic and Toiletry Formulations, 1995)**

The combined references fail to teach the pH of the composition.

Flick teaches that an alpha hydroxy acid cream comprising 14.2 % of lactic acid (88%) is formulated to pH of 3.5. See p. 114.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to formulate the composition of the combined references to pH of 3.5 as motivated by Flick because Rapaport teaches an alpha hydroxy acid cream wherein the alpha hydroxy acid is lactic acid used up to 30 % by weight; and Flick teaches the suitable pH of 14.2 % lactic acid (88%) composition. The skilled artisan would have had a reasonable expectation of successfully producing a stable alpha hydroxy acid cream composition that is suitable for topical application.

**Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rapaport and Quelle as applied to claims 12, 15-17 as above, and further in view of Flick.**

The combined references fail to teach the pH of the composition.



Flick teaches that an alpha hydroxy acid cream comprising 14.2 % of lactic acid (88%) is formulated to pH of 3.5. See p. 114.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to formulate the composition of the combined references to pH of 3.5 as motivated by Flick because Rapaport teaches an alpha hydroxy acid cream wherein the alpha hydroxy acid is lactic acid used up to 30 % by weight; and Flick teaches the suitable pH of 14.2 % lactic acid (88%) composition. The skilled artisan would have had a reasonable expectation of successfully producing a stable alpha hydroxy acid cream composition that is suitable for topical application.

**Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rapaport in view of Frei and Quelle.**

The references are discussed above. Rapaport further teaches a method of topically applying alpha hydroxy acid cream to treat stretchmarks in skin. The reference fails to teach soya peptide and tripeptide consisting of Gly-His-Lys.

Frei teaches fermented soya peptide extracted from Lactobacillus bacterium for increasing skin firmness, elasticity, and tone. See abstract; instant claims 1-4. The peptide is taught as have a molecular weight of 800-1300 Daltons. See p. 161; instant claim 5-6.

Quelle teaches the use of tripeptide Gly-His-Lys in cosmetic compositions to treat the skin against aging and as radical scavenger (antioxidant). See abstract.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the method of Rapaport by adding to the alpha hydroxy acid composition soya peptide and tripeptide, as motivated by Frei and Quelle, respectively.

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The motivation is found in the combined teachings of the references, as 1) Rapaport teaches that stretchmarks are treated by promoting the rigidity and elasticity of the skin, and suggests adding additives to enhance the performance of the product; such as botanical extracts and antioxidants; 2) Frei teaches that soya peptide effectively improves elasticity and firmness of the skin; and 3) Quelle teaches that the tripeptide promotes collagen synthesis and better antioxidant activity. The skilled artisan would have had a reasonable expectation of successfully enhancing the method treating stretchmarks since soya peptide and tripeptide are anti-aging agents suitable for cosmetic formulations.

### ***Allowable Subject Matter***

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: While Quelle teaches the tripeptide having the sequence Gly-His-Lys, the reference fails to teach or suggest the tripeptide conjugated with acetic acid or acetate in the form of a complex with zinc.

### ***Conclusion***

Claims 1-12, 14-19 are rejected.

Claim 13 is objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605.

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The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval<sup>2</sup>(PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gina C. Yu  
Patent Examiner

10/2/06